

## **REMARKS**

The Office Action noted that claims 1 and 13-26 are pending in the application, and that claims 1 and 13-26 are rejected. By this Amendment, claims 1 and 13-26 have been amended, claims 2-12 are cancelled, and new claims 27-44 have been added. Thus, claims 1 and 13-44 are pending in the application. Applicant respectfully submits that the amendments to claims, and new claims 27-44 are supported by the specification and drawings. No new matter has been introduced into the present application. The rejections are traversed below.

### **Official Notice**

The Office Action states "Applicant has attempted to challenge the Examiner's taking of Official Notice in the Office Action mailed May 2, 2008. There are minimum requirements for a challenge to Official Notice . . ." without any citation to where the minimum requirements may be found. Applicant is unaware of any minimum requirements, and respectfully request the citation to be provided. In addition, Applicant respectfully maintains that statements such as, "the Examiner has not provided proof that this element is well known" or "applicant disagrees with the Examiner's taking of Official Notice and hereby requests evidence in support thereof," are in fact adequate because these statements put the Office on notice that additional information is required to support the Official Notice. The burden is on the Office at all times to substantiate any claims of Official Notice. Applicant respectfully request that the previously indicated designation of Official Notice be rescinded.

### **Rejection Under 35 U.S.C. § 101**

Claims 1 and 13-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant has amended the claims to emphasize the computer implementation. Applicant respectfully submits that the amended claims, and new claims satisfy the requirements under 35 U.S.C. 101. Withdrawal of this rejection is respectfully requested.

### **Rejections Under 35 U.S.C. § 103**

Claims 1, 13-14, and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Getting Results Through Learning", a May 1997 publication of the Federal Human Resource Development Council (previously provided, hereinafter referred to as FHRDC) in view of Johnson et al. (US Patent #6,067,525).

Claims 15, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over FHRDC and Johnson et al. as applied to claims 13, 16 and 23 above, and further in view of Jacobs et al. (US Patent #6,049,794).

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over FHRDC and Johnson et al, and further in view of Miller et al. (US Patent #5,446,653).

Applicant respectfully traverses the rejections. Applicant thanks the Examiner for conducting the interview, at which time, Applicant described the prior art and the differences of the invention over the prior art. Applicant summarizes the discussion of the interview, the features of the present invention, and the distinguishing features of the prior art references cited in the Office Action.

### **What is the Virtual Mentoring invention?**

This invention is about managing claims by, for example, actively collecting metrics and results as well as re-calibrating models and processes for effectiveness in promoting the active learning of virtual mentoring. In some embodiments, the models are not static. The invention provides, for example, mentoring and/or claim handling assistance by continually evaluating the data elements and offers the knowledge at any point in time based on the changing facts of the claim.

The invention uses knowledge data sets to actively assign claims to qualified insurance claim professionals, and advise them, when appropriate, of actions that may be required to

successfully manage the claims to resolution. Since the invention uses data actively captured throughout the life of the claims, the invention also utilizes the data to evaluate the effectiveness of the assignments and various knowledge sets. In some embodiments, the invention periodically re-calibrates the knowledge data sets and adjusts them in order to continually improve upon results.

#### **Why is this invention important?**

- The assignee of the present application employs thousands of claim and medical professionals managing Worker's Compensation, Auto, General Liability and Property claims
- The assignee receives over 1 Million claims per year
- The invention has been actively used by the assignee to improve claim results and outcomes in the following areas:
  - Lost Time Days – The assignee processes claims in connection with injured workers, their employers and medical providers to return them to gainful and appropriate employment sooner.
    - The present invention assisted in the successful reduction of lost time days and saved indemnity payments per lost time claim
  - Regulatory Fines & Penalties – The assignee was able to reduce and eliminate these types of payments as a result of the use of the invention.

#### **Differentiators of the invention over the prior art**

- FHRDC
  - The FHRDC involves **people teaching people**. In contrast, the present invention involves a computer implementation using, for example, a computer that interfaces with, or interactively assists, the insurance claim professional.
  - The FHRDC involves teaching personnel oriented skills, i.e. team building, people management, interpersonal staff relationships. In contrast, **the present invention provides interactive mentoring and/or claims assistance in the**

management and processing of specific insurance claims made against the insurance policy that has been issued.

- Johnson
  - Johnson is used to generate leads and sales to make money. In contrast, the present invention does not make money, but instead is used to pay money out when processing insurance claims and making claimants as whole as possible against the loss they are claiming.
  - Johnson trains users how to make a sale. In contrast, the present invention focuses on managing insurance claims of insurance policies that have already been sold.
- Jacobs
  - Jacobs is used while evaluating patients. In contrast, the present invention is used by insurance claim professionals.
  - Jacobs is use to evaluate and treat patients. In contrast, the present invention is used by insurance claim professionals to evaluate and manage claimed losses from a variety of claims, including automobiles to property damages to injured employees.
  - In addition, the present invention does not dispense medical treatment nor advice.
- Miller
  - Miller constructs and issues insurance policies. In contrast, the present invention manages and processes insurance claims.
  - Miller uses state rules for policy issuance. In contrast the present invention uses state rules specific to the management of insurance claims which is drastically different from policy issuance, and state laws differ by line of business in the management of insurance claims.

Applicants' claim 1 is amended herein to focus on aspects of virtual mentoring that are specific virtual mentoring of claim professionals of an insurance organization. In particular, claim 1 is amended to clarify the use of predictive modeling, which comprises performing text and data mining of claim data collected from a plurality of claims of the insurance organization and performing predictive modeling of the claim data. This predictive modeling is described, for example, at page 11 lines 11–21 and page 14 lines 12–20 of the specification, and is part of the predictive logic (see, *e.g.*, page 14 lines 20–25 and FIGS. 2 and 3) of the virtual mentoring method as claimed. A method of virtual mentoring comprising predictive modeling of claim data collected from a plurality of claims of an insurance organization, as claimed, is not described or suggested in FHRDC.

Without conceding that FHRDC discloses any of the limitations in independent claim 1, FHRDC merely discusses data gathered regarding employees' "performance gaps or opportunities" (FHRDC, page 53), and summaries of conclusions of such studies (FHRDC, page 54). Classroom and electronic learning and performance strategies are described, generally, as being designed and selected to provide "just in time", "just the right" amount of content (FHRDC, pages 54 page 56). Cost-benefit analysis of the learning process is "consistently used in learning project proposals" and includes, for example "audience size" and "all costs associated with the design, development, implementation, delivery, and maintenance of the learning process for its estimated life" (FHRDC, page 55). **However, FHRDC does not, at Appendix C or elsewhere, disclose a method of virtual mentoring that incorporates predictive modeling of claim data collected from a plurality of claims of an insurance organization, as recited in claim 1.**

In addition, as described above, none of the remaining secondary prior art references, Johnson, Jacobs and/or Miller, fill in the above missing limitations form FHRDC.

Thus, Applicants respectfully submit that, for at least these reasons, the combination of elements recited in amended independent claim 1 is not rendered unpatentable by FHRDC. New independent claims 13 and 26, which also recite predictive modeling, and dependent claims 14–25, which recite further limitations to claim 13, are likewise distinguished. Accordingly, reconsideration and withdrawal of the § 103 rejection is respectfully requested.

Further, Applicant respectfully submits that new claims 27-44 provided independent unique combinations of elements that patentably distinguish over the prior art of record, when each claim is interpreted independently as a whole.

### CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, to the extent Applicants have discussed specific elements of the claims, Applicants have merely provided examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims as interpreted in view of the specification. Moreover, Applicants reserve the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

Any claims that have been cancelled are hereby cancelled without prejudice or disclaimer, and Applicants reserve the right to further prosecute these claims in continuing applications. In addition, Applicants have attempted to claim all embodiments disclosed in the present application, and no disclaimer of any embodiments is hereby intended by the presently pending claims.

Any narrowing amendments made to the claims, if any, in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents and/or statutory equivalents, *i.e.*, all equivalents that are substantially the same as the presently claimed invention.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintain the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

Applicants also traverse any "Official Notice," "Design Choice," "Admitted Prior Art" or other alleged prior art that the Examiner purports are well known with respect to the claimed combination of the present invention. Applicants disagree and request the Examiner to provide a prior art reference describing any of these features that the Examiner has not provided a prior art reference for or an affidavit under 37 C.F.R. Section 1.104(d)(2) providing details of why it would have been obvious. In the absence of either, Applicants request withdrawal of this rejection for these reasons as well.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.



### AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,  
WILMER CUTLER PICKERING HALE AND DORR LLP

Date: July 1, 2009

/Irah H. Donner/  
Irah H. Donner  
Registration No. 35,120

399 Park Avenue  
New York, NY 10022  
Tel: (212) 230-8887  
Fax: (212) 230-8888